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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,027	12/22/2001	Martha Lillian Tate	15,855	2967

23556 7590 08/19/2004

KIMBERLY-CLARK WORLDWIDE, INC.
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EXAMINER

KIDWELL, MICHELE M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 08/19/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,027

Applicant(s)

TATE ET AL.

Examiner

Michele Kidwell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4-5,7-9</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 – 12, 14, 16, 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

MPEP 2173.05 (h) states that :

Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being “selected from the group consisting of A, B and C.” See *Ex parte Markush*, 1925 C.D. 126 (Comm’r Pat. 1925).

The applicant has failed to correctly list the above referenced claims as a proper Markush group. Therefore, the scope and clarity of the claims is uncertain and ambiguous. Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe et al. (US 5,635,191).

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With respect to claims 1, 3 – 5, 20 and 22 – 23, the applicant is referred to MPEP 2113, which states that:

“[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted)

The examiner reminds the applicant that:

“[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.” *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

Accordingly, Roe et al. (hereinafter “Roe”) discloses an absorbent article comprising an outer cover, a liquid permeable bodyside liner that defines a bodyfacing surface and that is connected in a superposed relation to the outer cover, an absorbent body that is located between the bodyside liner and the outer cover (col. 4, lines 18 – 30) and a composition on at least a portion of the bodyfacing surface of the bodyside liner wherein the composition has a Tangent Delta value of from about 0.10 to about 0.65 measured over a temperature range of 35 to 40 degrees Celsius according to a Tangent Delta Measurement Procedure set forth in col. 12, lines 66 – 67, col. 22, lines 1 – 25 and col. 12, lines 29 – 61.

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The examiner contends that the Roe reference discloses the specifics of the composition as fully explained in the following rejection of claim 7, thereby providing a composition that will yield similar results when subjected to the Tangent Delta Measurement Procedure.

Regarding claims 2 and 21, Roe discloses a composition with the claimed softening temperature as set forth in col. 9, lines 55 – 60.

As to claims 6 and 7, Roe discloses an absorbent article comprising an outer cover, a liquid permeable bodyside liner that defines a bodyfacing surface and that is connected in a superposed relation to the outer cover, an absorbent body that is located between the bodyside liner and the outer cover (col. 4, lines 18 – 30) and a composition on at least a portion of the bodyfacing surface of the bodyside liner and a composition on at least a portion of the bodyfacing surface of the bodyside liner that includes from about 40 to about 95 percent by weight of emollient (col. 12, lines 66 – 67), from about 0.1 to about 40 percent by weight of viscosity enhancer (col. 22, lines 1 – 25) and from about 0.1 to about 20 percent by weight of silicone elastomer as set forth in col. 12, lines 29 – 61.

As to claim 8, Roe discloses an emollient of the composition to be selected from the listed group as set forth in col. 11, lines 1 – 3.

With reference to claim 9, Roe discloses a viscosity enhancer of the composition to be selected from the listed group as set forth in col. 22, lines 1 – 25.

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Regarding claims 10 – 12, Roe discloses the silicone elastomer of the composition to be selected from the listed group as set forth in col. 11, line 43 to col. 12, line 45.

With respect to claims 13 and 14, Roe discloses an absorbent article wherein the composition further includes from about 5 to about 59 percent by weight of a solidifying agent selected from the listed group as set forth in col. 16, lines 23 – 30.

With reference to claims 15 – 16, Roe discloses an absorbent article wherein the composition further includes from about 0.1 to about 59 percent by weight of one of the natural fats or oils as listed as set forth in col. 17, lines 19 – 29.

Regarding claims 17 – 18, Roe discloses an absorbent article wherein the composition further includes from about 0.1 to about 10 percent by weight of sterols or sterol derivatives selected from the listed group as set forth in col. 12, line 58.

As to claim 19, Roe discloses an absorbent article wherein the composition further includes a skin care ingredient selected from the listed group as set forth in col. 11, lines 1 – 3.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 703-305-2941. The examiner can normally be reached on Monday - Friday, 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Michele Kidwell
Examiner
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